

### **REMARKS**

Claims 1-21 are pending in this application.

The Office Action dated October 20, 2005, has been received and carefully reviewed. In that Office Action, claims 6, 9, 15, 16, 20 and 21 were rejected under 35 U.S.C. 103(a) as being unpatentable over Motoyama. Claims 1-21 were rejected under 35 U.S.C. 103(a) as being unpatentable over Motoyama in view of Horvitz. It is believed that the pending claims are allowable over the references of record, and reconsideration and allowance of claims 1-21 is respectfully requested in view of the following remarks.

### **REJECTIONS BASED ON MOTOYAMA**

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Motoyama. As an initial matter, it is noted that this rejection under Section 103 does not explain what element is missing from Motoyama or explain how Motoyama is being modified in order to meet the terms of the pending claims. If this is a rejection under Section 103, therefore, it is respectfully submitted that a motivation for modifying Motoyama has not been identified and that a *prima facie* case of obviousness has not been presented. Based on the rejection, however, it appears that this rejection could be a rejection under 35 U.S.C. 102(b) based on the argument that one of the claimed elements, which is not shown in Motoyama, is inherently present in Motoyama and in "any software." This argument is addressed below. However, it is respectfully requested that, if all claims are not allowed in response to this Reply, the examiner clarify the grounds for rejecting claims 6, 9, 15, 16, 20 and 21 in an Advisory Action.

Claim 6 requires a service management method and includes the limitation, "wherein, the functions are grouped into at least a first level and a second level, at least one function in the first level being associated with at least one function in the second level." The Office Action indicates that "having functions grouped into different levels and being associated to each other is an inherent part of any software." It therefore appears that the Office Action is acknowledging that the above limitation is not expressly described in Motoyama but is arguing that this limitation is inherently present in Motoyama.

It is respectfully submitted that the above limitation is not inherently present in

Motoyama. As provided in Section 2112 of the MPEP, "The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." *In re Rijckaert*, 28 U.S.P.Q. 2d 1955, 1957 (Fed. Cir. 1993). The MPEP also cites *Ex parte Levy*, 17 U.S.P.Q. 2d 1461, 1464 (BPAI 1990) for the proposition that "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." In the present case, it is respectfully submitted that no such basis in fact and/or technical reasoning has been provided to show that Motoyama, much less "any software," will have functions grouped into at least a first level and a second level so that least one function in the first level is associated with at least one function in the second level. The Office Action has not established grounds for relying on the inherency of the above feature, and claim 6 is submitted to be allowable over Motoyama for at least this reason.

The Office Action also indicates that Motoyama shows that at least one function in a first level be identified as used only if all functions in a second level that are associated with the at least one function are identified as used. Motoyama, however, does not identify first and second levels of functions that are associated as claimed (these features are only asserted to be inherent in the reference). Therefore, Motoyama cannot show how certain (undisclosed) functions are identified as "used" as required by claim 6. Claim 6 further distinguishes over Motoyama this reason. If the examiner is asserting that the limitation "at least one function in a first level is identified as used only if all functions in a second level that are associated with the at least one function are identified as used" is also inherent in Motoyama, this statement is respectfully traversed for the same reasons as the previous reliance on inherency was traversed. It is also respectfully requested if this limitation is also alleged to be inherent in Motoyama, the examiner provide a statement to this effect in an Advisory Action.

Claims 9, 15, 16, 20 and 21 are rejected for the same reasons as claim 6. Each of these claims includes the limitation "functions are grouped into at least a first level and a second level, at least one function in the first level being associated with at least one function in the second level." The rejection of these claims is traversed for the same reasons provided above in

connection with claim 6.

#### REJECTIONS BASED ON MOTOYAMA AND HORVITZ

Claim 1 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Motoyama in view of Horvitz. Claim 1 requires steps of 1) checking usage conditions of a plurality of functions to determine which functions have been used less than a predetermined number of times, and 2) making the computer carry out notification and promotion processing to promote a user to use a function from among the functions which have been determined to have been used less than a predetermined number of times. Neither reference discloses a step of checking usage conditions of a plurality of functions to determine which functions have been used less than a predetermined number of times. The Office Action acknowledges that this step is not shown in Motoyama and cites to column 23 line 61 to column 24, line 23 to show this feature in Horvitz. These columns of Horvitz, however, merely discuss displaying a help screen when a user might need assistance. Types of assistance might include formatting help and spell checking help. There is no indication in Horvitz that formatting commands or spell checking commands have been used less than a predetermined number of times as claimed. This combination of references, even if proper, does not show or suggest the invention required by claim 1. Claim 1 and its dependent claims are submitted to be allowable over Motoyama in view of Horvitz for at least this reason.

Claims 3, 5, 12, 13, 14, 17 and 18 are rejected for the same reasons as claim 1. Claims 3, 5, 12, 13, 14, 17 and their dependent claims are all submitted to be allowable for at least the same reasons as claim 1.

Applicant also maintains that a motivation for combining Motoyama and Horvitz has not been provided and that therefore a *prima facie* case of obviousness based on these references has not been provided. The Office Action now indicates that motivation for combining the references can be found from “studies of the use of models for reasoning about the intensions of people” mentioned at Horvitz, column 1, lines 49-65. These models and studies are not described at all. It is respectfully submitted that the existence of unexplained studies and models does not provide a motivation for combining Motoyama and Horvitz. It is therefore again

submitted that a motivation for combining the references has not been identified, that a *prima facie* case of obviousness has not been presented, and that claims 1-21 are allowable over the references of record.

The Office Action includes the statement "The conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint or suggestion in a particular reference." *In re Bozek*, 163 U.S.P.Q. 545 (CCPA 1969). It thus appears that the examiner may believe it is not necessary to identify a motivation for combining references. If this is accurate, it is respectfully requested that the examiner include such a statement in an Advisory Action as this will greatly simplify issues for appeal. It is noted that the Federal Circuit commented on the *Bozek* case as follows:

The case on which the Board relies for its departure from precedent, *In re Bozek*, 416 F.2d 1385, 163 U.S.P.Q. 545 (CCPA 1969), indeed mentions "common knowledge and common sense," the CCPA stating that the phrase was used by the solicitor to support the Board's conclusion of obviousness based on evidence in the prior art. *Bozek* did not hold that common knowledge and common sense are a substitute for evidence, but only that they may be applied to analysis of the evidence. *Bozek* did not hold that objective analysis, proper authority, and reasoned findings can be omitted from Board decisions. Nor does *Bozek*, after thirty-two years of isolation, outweigh the dozens of rulings of the Federal Circuit and the Court of Customs and Patent Appeals that determination of patentability must be based on evidence.

The requirement of providing a motivation for combining references, as set forth by the Federal Circuit in "dozens of cases" and as provided in the MPEP can not be disregarded based on this single, 35 year old case. Thus, if the present rejections are based on the assertion that no motivation for combining references needs to be identified, the rejections are traversed as not being in accordance with applicable law.

Claim 4 is also rejected under 35 U.S.C. 103(a) as being unpatentable over Motoyama and Horvitz. However, claim 4 is not specifically mentioned in the body of the Office Action. Furthermore, the limitations of claim 4, relating to notification based on content, for example, are not addressed in the Office Action. These limitations are not shown or suggested by the art of record. It is therefore respectfully submitted that the Office Action has not presented a *prima facie* case of obviousness in connection with claim 4, and that claim 4 is allowable over the art of

record.

### CONCLUSION

Each issue raised in the Office Action dated October 20, 2005, has been addressed, and it is believed that claims 1-21 are in condition for allowance. Wherefore, reconsideration and allowance of these claims is earnestly solicited.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Scott Wakeman (Reg. No. 37,750) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

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